

REMARKS

Examination of the application is respectfully requested.

I. Status of the Claims

Claims 1-25 and 36-38 were previously canceled without prejudice or disclaimer of the subject matter therein.

Claim 26 has been amended and the amendment does not add new matter.

Claims 26-35 and 39-43 are currently pending.

II. Election/Restriction

Further to the Restriction Requirement imposed in the Official Action dated September 26, 2006, the Examiner has imposed another Restriction Requirement, as follows:

Group I: Claims 26-28;

Group II: Claims 29-31, and 41-43;

Group III: Claims 32-35 and 39-40.

The Examiner contends that the Amendments made in the response dated October 26, 2006 necessitated the second Restriction Requirement. In response, Applicant provisionally elected Group III, claims 32-35 and 39-40 via a telephone conference with the Examiner on November 2, 2006. The election was with traverse. The Arguments set forth below were discussed with the Examiner during the telephone conference of November 2, 2006.

Applicant respectfully traverses the present Restriction Requirement. In the first Restriction Requirement dated September 26, 2006, the Examiner divided the claims of the application into three groups and Applicant selected Group III, directed to “a method of changing a transaction from a first market type to a second market type” as set forth by the Examiner (Official Action dated September 26, 2006, page 2). In addition to the claims pending at the time of the first Restriction Requirement, Applicant added claims 39-43, all directed to a method of changing a transaction from a first market type to a second market type.

Applicant submits that the amendments to the claims did not change the scope of the invention, but were made to clarify the language of the claims. Claim 26 originally recited:

rejecting the acceptance of the transaction on the first market type at the first client device; and transmission of a reject accept message containing an account identifier ... [and]
receiving the account identifier associated with an account located at a clearinghouse device from the first client device at the second client device.

The claim was amended previously to recite:

rejecting the acceptance of the transaction ~~[[on]] of~~ the first market type at the first client device; ~~and transmission of~~
transmitting a reject accept message containing an account identifier from the first client device to a clearinghouse device ... [and]
receiving the account identifier associated with an account located at ~~[[a]] the~~
clearinghouse device ~~from the first client device at the second client device~~;

Claim 26 is currently being amended to correspond to an embodiment of the invention described on page 13 of the Specification:

transmitting a reject accept message containing an account identifier from the first client device to ~~a clearinghouse~~ the second client device.

Claim 26 as amended, recites that the reject accept message is transmitted from the first client device to the second client device. The remaining amendments were primarily minor wording modifications to the claim.

Claim 29 originally recited:

receiving an accept offer message at a first client device for a transaction to occur on a first market type having an account identifier; ... [and]
transmitting the account identifier and another account identifier associated with the first client device.

Claim 29 was then amended to:

receiving, at a first client device, an accept offer message ~~at a first client device~~ for a transaction to occur, [[on]] said transaction being of a first market type, and having [[an]] a second account identifier associated with a second client device; ... [and] transmitting the second account identifier and ~~another~~ a first account identifier associated with the first client device from the first client device to a clearinghouse device.

Thus, claim 29 was amended to recite that a second account identifier was associated with the second client device and that the first and second account identifiers were transmitted from the first client device to the clearinghouse. The remainder of the amendments were to place the claim in better form. Thus, the claim recites, as was in the original claim, the method of changing the transaction from a first market type to a second market type.

Claim 32 originally did not state that the first client device transmitted the offer to the second client device. Claim 32 was amended to recite:

at a first client device connected to a network, transmitting an offer offering to a second client device connected to the network, to conduct the transaction [[in]] of the first market type ~~from a first client device connected to a network.~~

The claim was amended to add that the first client device transmits the offer to the second device. All other amendments were to clarify the language of the claim. Thus, claim 32 continues to recite a method of changing the transaction from a first market type to a second market type.

Thus, the scope of the claims was not significantly changed. The Examiner's determination that these amendments resulted in three distinct inventions is simply not warranted. The same inventive concept that was previously identified by the Examiner, a method of changing a transaction type, is still what is recited in the claims.

MPEP § 803(I) sets forth the criteria for a proper restriction requirement:

“(A) The inventions must be independent or distinct as claimed; and

(B) There would be a serious burden on the examiner if restriction is not required.”

Applicant submits that the inventions as defined by the Examiner in the second Restriction Requirement are not “independent or distinct.” All the pending claims are directed to methods, involve at least two parties to a transaction, convert a transaction from a first market type to a second market type and transmit a confirmation. The “inventions” as set forth in the individual claims all relate to the single inventive concept identified by the Examiner.

Additionally, Applicant submits that there is no serious burden on the Examiner to search the invention described in independent claims 26, 29, and 32. Given the nature of the technology, a search directed to claim 32 will undoubtedly overlap with a search directed to claims 26 and 29. As discussed above, the independent claims share numerous features and those features will be searched for in the same way and in the same classes and subclasses. Searching the same classes and subclasses, using the same parameters for the search and searching for the same “type” of claims (method) does not present a serious burden to the Examiner. Thus, Applicant submits that

neither the first nor the second criteria set forth above are met. The Restriction Requirement is therefore improper, and all pending claims, 26-35 and 38-43, should be examined together on the merits.

Applicant respectfully requests that the Restriction Requirement be withdrawn and all pending claims be examined.

CONCLUSION

Applicant believes the pending application is in condition for allowance. Accordingly, the Examiner is respectfully requested to examine this application and pass it to issue.

The Examiner is respectfully requested to contact the undersigned at the telephone number indicated below if the Examiner believes any issue can be resolved through either a Supplemental Response or an Examiner's Amendment.

Dated: November 30, 2006

Respectfully submitted,

By 
Louis J. DelJuice

Registration No.: 47,522
DARBY & DARBY P.C.
P.O. Box 5257
New York, New York 10150-5257
(212) 527-7700
(212) 527-7701 (Fax)
Attorneys/Agents For Applicant